| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/955,376 | 09/17/2001 | Brien M. Oberstein | 10934-003 | 8356 |

| 20583 | 7590 | 01/21/2005 |
|---|---|---|

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| EXAMINER |
|---|
| PROCTOR, JASON SCOTT |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2123 | |

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/955,376 | OBERSTEIN ET AL. |
| | Examiner | Art Unit |
| | Jason Proctor | 2123 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.    2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-31* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-31* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>07 November 2001</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some *   c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/28/2002</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

### *Priority*

1.      Applicant's claim for domestic priority to applications 60/297,116 filed June 8,

2001 and 60/233,458 filed September 18, 2000 under 35 U.S.C. 119(e) is

acknowledged.

### *Information Disclosure Statement*

2.      The information disclosure statement filed June 28, 2002 fails to comply with 37

CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each

publication or that portion which caused it to be listed; and all other information or that

portion which caused it to be listed.  It has been placed in the application file, but the

information referred to therein has not been considered.

3.      Specifically, references AT, AU, and AV have not been found in the record and

therefore have not been considered by the Examiner.  Applicant is respectfully

requested to submit copies of these references so that they may be considered.

### *Claim Rejections - 35 USC § 101*

4.      35 U.S.C. § 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

5.      Claims 1-31 are rejected under 35 U.S.C. § 101 because the claimed invention is

directed to non-statutory subject matter.

6.      Claim 1 recites limitations which, when given their broadest reasonable interpretation, encompass a human being.  In particular, there are no limitations which are specifically directed to the technology arts, and "permitting said testing system access to a server running said scripts" does not require that the testing system actually perform interaction with a server.

7.      MPEP 2106(II)(A) states:

> The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

8.      Claims 1-8 fail to recite a useful, concrete, and tangible result.  The limitations of claim 1 fail to clearly achieve the method of the preamble, emulating a transaction.  The limitations of claim 6 perform a determination, however there is not recited a useful, concrete, and tangible result.

9.      Claims 9-10 and 12-13 fail to recite a useful, concrete, and tangible result.  The recited limitations fail to clearly achieve the method of the respective preambles.  In contrast, claims 11 and 14 introduce limitations which recite a useful, concrete, and tangible result of the nonstatutory methods of claims 9-10 and 12-13.

10.     MPEP 2106(IV)(B)(1) recites:

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.

11.　　Claims 15-31 recite computer software *per se* and are therefore nonstatutory.

12.　　To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. § 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

## *Drawings*

13.　　The drawings are objected to because they contain hand-written reference numerals and are therefore informal. The drawings are objected to because they contain shading which does not comply with 37 CFR 1.84(m) as in Figs. 2, 2A, 14, and others. The drawings are objected to because the numbering of the drawing sheet depicting Fig. 10 does not comply with 37 CFR 1.84(t). The Examiner respectfully requests that Applicant review the drawings in their entirety for compliance with 37 CFR 1.84. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. The replacement sheet(s) should be labeled "Replacement

Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

the drawing figures. If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.


### *Specification*

14.     Applicant is reminded of the proper language and format for an abstract of the

disclosure.  MPEP 608.01(b) states:

> The abstract should be in narrative form and generally limited to a single paragraph on a separate
> sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words
> in length since the space provided for the abstract on the computer tape used by the printer is
> limited. The form and legal phraseology often used in patent claims, such as "means" and "said,"
> should be avoided. The abstract should describe the disclosure sufficiently to assist readers in
> deciding whether there is a need for consulting the full patent text for details.
>
> The language should be clear and concise and should not repeat information given in the title. It
> should avoid using phrases which can be implied, such as, "The disclosure concerns," "The
> disclosure defined by this invention," "The disclosure describes," etc.

15.     The abstract of the disclosure is objected to because it needlessly comprises two

paragraphs.  Correction is required.  See MPEP § 608.01(b).


16.     A substitute specification including the claims is required pursuant to 37 CFR

1.125(a) because the specification fails to comply with the requirements of 35 U.S.C. §

112, first paragraph, in instances too numerous to cite completely. Examples of the specification's deficiencies are given below in the claim rejections under 35 U.S.C. § 112, first paragraph. In particular, the written description requirement is inadequately fulfilled to the extent that the Examiner cannot appropriately ascertain what would be required in the prior art to teach the limitations of the claimed invention. Further, the claims recite numerous limitations which are admitted by the Applicant as automating a previously manual activity (page 7, lines 13-14; page 11, line 26 – page 12, line 7; page 15, lines 2-3). MPEP 2144.04 states:

> *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Further, claims 9 and 12 recite inventions which are either admitted prior art or fail to overcome the admitted deficiencies of prior art. Page 6, lines 22-24 of the specification states:

> It is not enough to verify that a message was received by the connected application – a thorough test must also verify that appropriate information has been presented correctly to the person using that application.

Claim 9 concludes with a step of receiving a message indicating that transmitted test data was successfully received. Claim 12 concludes with a step of sending a message indicating that received test data was successfully received. Both claims appear to suffer from the deficiency of the prior art and therefore the utility of these claimed inventions must be called into question.

17.    A substitute specification must not contain new matter.   The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record.   The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters.   The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.   An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied.   Numbering the paragraphs of the specification of record is not considered a change that must be shown.

### Claim Rejections - 35 USC § 112

18.    The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

19.    Claims 1-8 and 15-31 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.  The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

20.    Regarding claim 1, the step "identifying unique aspects of the tested system" is

described ambiguously by the specification at page 7:

> Identify unique aspects of system B's business processing with regard to FIX. In this step, B
> identifies optional fields and formatting in the FIX protocol that its system requires. B also
> identifies custom fields that it has added for its business processes, and identifies changes to the
> semantics of the FIX protocol that it has made to support its business processes.

B is defined as an "ECN-type securities trading network" at page 7, lines 3-4. It appears

to the Examiner that this step is performed by a human operator associated with the

ECN-type securities trading network B rather than by the network B itself. The

disclosure is silent as to how a human operator would go about identifying unique

aspects of the tested system. The teachings of the disclosure are directed toward the

abstract idea that the unique aspects of the tested system should be identified rather

than concretely teaching how to perform the step of identifying the unique aspects of the

tested system.

21.    Further regarding claim 1, the step "modifying scripts to model said emulated

system, including said unique aspects" is described ambiguously at page 7:

> Download and modify scripts from T's server. Using applicable scripted logic provided by system
> T, B writes a subset of scripts to capture behavior unique to its system. These smaller scripts are
> linked to the original set of scripts from T's server. B sets up specific data formats for ID fields
> and adds customized FIX session enhancements.

Again, it is presumed by the Examiner that this step is performed by a human operator

associated with the ECN-type securities trading network B rather than by the network B

itself. As with the step of "identifying unique aspects of the tested system", the

teachings of the disclosure are directed toward the abstract idea that the scripts should

be modified rather than concretely teaching how to perform the step of modifying scripts

to model the emulated system, including its unique aspects.

22.    Further regarding the steps of claim 1 mentioned above, page 14, line 26 – page

16, 23 of the specification describes the preferred process for writing and managing

scripts.  Rather than describing how a human operator would identify unique aspects of

the tested system or modify scripts to model the emulated system, this section

describes the format of a script at page 15, lines 18-28 and teaches that:

> All scripts preferably can be developed with a simple text editor

Page 15, line 12, and

> To edit a script, a user copies it and pastes it to a text editor.

Page 15, line 15.

The Examiner remarks that pasting a script into a text editor does not constitute

"modifying scripts to model said emulated system, including unique aspects".


23.    Regarding claim 6, the step "determining how said messaging engine validates

incoming messages and composes outgoing messages" is recited at page 3, lines 16-

20:

> In still a further embodiment, the step of modifying scripts comprises the steps of: (a) dynamically
> determining the behavior of the messaging engine by running tests and logging test results; (b)
> parsing said logged test results; and (c) determining how said messaging engine validates
> incoming messages and composes outgoing messages.

However, the disclosure fails to provide any concrete teaching regarding this step.

Again, the disclosure is directed toward the abstract idea that such a determination

should be made but provides no details regarding how to make this determination.


24.    Regarding claim 15, the software components "script writing software" and "script

executing software" are not described by the specification and therefore the claim fails

to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

To wit, page 15, lines 12-15 recite:

> All scripts preferably can be developed with a simple text editor. To access scripts, a user can go to the Admin Tools menu page (see FIG. 9), click the Manage Scripts link 940. It is recommended that a user set up a local script repository to manage the scripts locally.
> To edit a script, a user copies it and pastes it to a text editor.

While the use of a simple text editor is clearly taught by the specification, the structure, implementation, appearance, and functionality of the script writing software are not taught anywhere in the disclosure. In the Examiner's broadest interpretation of the cited portion of the specification, the "simple text editor" appears to be software external to the invention. If the "simple text editor" is other than known in the art or is an integral component of the invention of claim 15, such a teaching is absent from the disclosure. The limitations of claim 15 recite script writing software, which is not adequately described by the disclosure, rather than the use of a text editor and are therefore fail to comply with the written description requirement.

25.     Regarding claim 21, the limitation "dynamic HTML generating software controllable by a script" is not taught by the disclosure. The specification asserts that such a feature could be included (page 17, 23-26) but provides no concrete teaching of this limitation other than by name.

26.     Regarding claim 25, the limitation "a second set of scripts linked to the first set of scripts, said second set of scripts emulating a transaction processing system that

implements said protocol definition" is not taught by the disclosure. The specification

appears to attempt to support this limitation at page 7, lines 21-24:

> Download and modify scripts from T's server. Using applicable scripted logic provided by system T, B writes a subset of scripts to capture behavior unique to its system. These smaller scripts are linked to the original set of scripts from T's server. B sets up specific data formats for ID fields and adds customized FIX session enhancements.

Nowhere does the disclosure provide a concrete description of the link between the

smaller scripts and the original scripts.

27.    Claims rejected but not specifically mentioned stand rejected by virtue of their

dependence.

28.    The Examiner respectfully requests that the Applicant review the scope of patent

protection sought for the disclosed invention with regard to 35 U.S.C. § 112, first

paragraph.

29.    The following is a quotation of the second paragraph of 35 U.S.C. § 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

30.    Claims 1-31 are rejected under 35 U.S.C. § 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

31.    Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 1 recites "a method of emulating an emulated

transaction processing system" which is vague and indefinite. It is unknown to the Examiner what is meant by "emulating an emulated system". It is unknown whether the prior art must show emulation of an emulation in order to teach the claimed invention or whether a single level of emulation would suffice.

32.     Further regarding claim 1, the limitation "permitting said testing system access to a server running said scripts" is indefinite. The meaning of "permitting access to a server" is so broad and open to interpretation that it is unclear to the Examiner how this limitation defines the claimed invention.

33.     Regarding claim 6, it is unclear what is meant by the limitation "determining how said messaging engine validates incoming messages and composes outgoing messages". The meaning of this term is so broad and open to interpretation that it is unclear to the Examiner how this limitation defines the claimed invention. Presumably the designers of a messaging engine have already determined how the engine validates incoming messages and composes outgoing messages else it would be impossible to implement the messaging engine. One interpretation of this limitation would relate to reverse engineering a messaging engine. Clarification is required.

34.     Regarding claim 9, the limitation "establishing communication with an emulating system that emulates behavior of the emulated system using scripts" is indefinite. The preamble recites no structure that makes clear what form or type of communication is intended by the limitation. The other limitations appear to recite computer networking

communication to and from the emulating system, but it is unclear with what the emulating system is communicating.

35.    Further, it is unclear how the recited limitations achieve the method recited in the preamble.  No limitation addresses testing compatibility and it is unknown how the method achieves this goal while only communicating with the emulating system.

36.    Regarding claim 12, the limitation "establishing a communication with the testing system" is indefinite.  The preamble recites no structure that makes clear what form or type of communication is intended by the limitation.  The other limitations appear to recite computer networking communication to and from the testing system, but it is unclear with what the testing system is communicating.

37.    Further, it is unclear how the recited limitations achieve the method recited in the preamble.  No limitation addresses compatibility testing and it is unknown how the method achieves this goal while only communicating with the testing system.

38.    Claim 15 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.  Claim 15 recites "software for emulating an emulated transaction processing system" which is vague and indefinite.  It is unknown to the Examiner what is meant by "emulating an emulated system".  It is unknown whether the prior art must show emulation of an emulation in order to teach the claimed invention or whether a single level of emulation would suffice.

39.     Claim 24 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.   Claim 15 recites "software for emulating an emulated transaction processing system" which is vague and indefinite.  It is unknown to the Examiner what is meant by "emulating an emulated system".  It is unknown whether the prior art must show emulation of an emulation in order to teach the claimed invention or whether a single level of emulation would suffice.

40.     Regarding claim 25, the term "wherein said application programming interface is configured to pass inbound and outbound messages to said second set of scripts" is vague and indefinite.  It is unknown to the Examiner what functionality is implied by the term "scripts" such that passing inbound and outbound messages to the scripts is productive.  The Examiner presumes that the inbound and outbound messages are passed to the "script interpreting engine" recited in an earlier limitation of claim 25.

41.     Claims rejected but not specifically mentioned are rejected by virtue of their dependence.

42.     In general, the claims are replete with issues under 35 U.S.C. § 112, second paragraph.  As a result, the Examiner respectfully requests that Applicant review the

claim language for compliance with 35 U.S.C. § 112, second paragraph, beyond the rejections listed above.

### *Claim Interpretation*

43.    In the interest of compact prosecution, examiner makes the following claim interpretations in order to apply prior art to the claims.    See *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984).

44.    Regarding claims 1-31, it is the Examiner's best interpretation of the claim limitations, in light of the disclosure, that Applicant's invention is:

A method and system for validation of software which performs transactions with a remote server via a communications network, the method and system comprising:

an emulator that emulates the operations of the remote server;

a test script that defines the operations of the software to be validated;

the software under test communicates with the emulator;

the emulator performs validation by returning an emulated response to the

software communication; and

a display that informs the user of whether the emulated response confirms

the valid operation of the software.

45.    In addition, various claims recite communications protocols employed by the software under test and the emulator.

## *Claim Rejections - 35 USC § 103*

46.    The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

47.    Claims 1-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over

Mongan et al. US Patent No. 6,304,982, hereafter referred to as Mongan, in view of

Stilwell et al. US Patent No. 5,907,696 hereafter referred to as Stilwell.

48.    Mongan teaches a method of testing software including a test manager which

analyzes the results of tests performed by the client computers and determines which

tests have passed or failed (column 2, lines 61 – 67). Mongan also teaches that the

operator is presented with a display indicating the results of the tests (column 3, lines 3-

8). Mongan also teaches that a server computer and/or the client computers can

execute the client program, application program, test script, and test manager (column

3, lines 33-45).

49.    Mongan does not teach emulating a remote server or that the software

necessarily communicates with a remote server.

50.    Stilwell teaches emulation of the operation of a network device to facilitate

development of software which communicates with the network device (column 2, lines

36-52).

51.    While Stilwell does not explicitly teach emulating the performance of an arbitrary

network device, it would have been obvious to a person of ordinary skill in the art at the

time of Applicant's invention in combination with his own knowledge of the particular art

that the teachings of Stilwell would be applicable to emulating an arbitrary network

device.

52.    It would have been obvious to a person of ordinary skill in the art at the time of

Applicant's invention to combine the network device emulation taught by Stilwell with

the scripted software testing and validation taught by Mongan in order to better facilitate

the development, testing, and validation of software which communicates with a remote

server.  The combination could be achieved by emulating the operation of the remote

server such that the test script controls the software being tested to communicate with

the emulated server and concluding the test is successful when the emulated response

is as desired.

53.    Regarding the various communication protocols recited, it would have been

obvious to a person of ordinary skill in the art at the time of Applicant's invention in

combination with his own knowledge of the particular art, when designing software that

communicates with a remote server, to use one of the various communication protocols

known in the art.

54.    Further, MPEP 2144.04 states:

> *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to
> a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art
> because the claimed invention combined "old permanent-mold structures together with a timer
> and solenoid which automatically actuates the known pressure valve system to release the inner
> core after a predetermined time has elapsed." The court held that broadly providing an automatic
> or mechanical means to replace a manual activity which accomplished the same result is not
> sufficient to distinguish over the prior art.).

55.    Where the claims recite limitations related to the validation of software that communicates with a remote server, Applicant's admissions (page 7, lines 13-14; page 11, line 26 – page 12, line 7; page 15, lines 2-3) establish the invention as automating a manual activity and therefore unpatentable as obvious over Applicant's admission of prior art.


## *Conclusion*

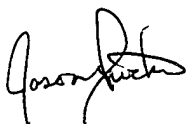Art considered pertinent by the examiner but not applied has been cited on form PTO-892.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Proctor whose telephone number is (571) 272-3713.  The examiner can normally be reached on 8:30 am-4:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin J Teska can be reached on (571) 272-3716.  The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.   Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Jason Proctor
Examiner
Art Unit 2123

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